
(2009) 11 BOM CK 0061

In the Bombay High Court

Case No : Notice of Motion No. 1566 of 2009 and Notice of Motion No. 2642 of 2007 in Suit No. 1956 of 2007

Reed Elsevier Properties Inc. and Another

APPELLANT

Vs

Best Media Associates (India) Pvt. Ltd.

RESPONDENT

Date of Decision : 11-11-2009

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 109(2), 46
Trade Marks Act, 1999 — Section 1(2), 2, 34, 34(2), 34(3)

Citation : (2010) 1 BomCR 839 : (2010) 112 BOMLR 257

Hon'ble Judges : S.J. Vazifdar, J

Bench : Single Bench

Advocate : Virendra Tulzapurkar, Ashish Kamat, Shardul Thacker, Bindiya Raichura and Aarti Shah, instructed by Mulla and Mulla, C.B.C, for the Appellant; Rahul Chitnis, Ramesh Gajria, A.S. Daver and Deepa Hate, instructed by Gajria and Co., for the Respondent

Judgement

S.J. Vazifdar, J.—This is an action for passing off and infringement of the Plaintiffs trade marks and copy rights. The Plaintiff has sought a permanent injunction restraining the Defendant from using the word "variety" and the flying "V" logo and/or any other similar or deceptively similar marks, style and/or logo as part of the Defendant's publications, website, trading style or otherwise so as to infringe the Plaintiffs registered trade mark variety. The Plaintiff has also sought a perpetual injunction restraining the Defendants from passing off its publications and/or website as that of the Plaintiffs by using the said mark and logo and/or any other mark or logo similar or deceptively similar thereto, a permanent injunction restraining the Defendant from infringing its copy right in the original artistic work as shown in Exh. "A" to the plaint and a mandatory Order directing the Defendant to forthwith change the name of its publications and/or website so as to ensure that the word "variety" and the logo do not appear therein.

2. Plaintiff No. 1 and Plaintiff No. 2, "Variety Inc." are corporations registered in the United States of America. Plaintiff No. 1 is the owner of a domain mark

"Variety" wherein, the letter "V" is written in a stylized manner. The second stroke extends over the letters "ARIETY" in the shape of the blade of a cutlass. Plaintiff No. 1 is also the owner of various other trade marks wherein, the word "Variety" forms a part such as "Daily Variety," "Daily Variety Gotham" and "Variety.com" and stylizations thereof.

3. Plaintiff No. 2 carries on business inter alia of publishing newspapers, magazines, directories and online media and marketing services in various countries. Plaintiff No. 2 is the licensee of Plaintiff No. 1 in respect of the variety marks. It has correspondents in several countries including India. The Defendant also carries on business of publishing inter alia directories for the cinema industry using the word "Variety" therein namely, "Variety Cinema Directory". The Defendant also uses the word "variety" in its website www.varietydirectory.com.

4. The Predecessor of Plaintiff No. 1 has since the year 1905 used the said trade mark "Variety" and the logo extensively. The Plaintiffs' publications provide extensive coverage of media, television and the film industry covering global media and the entertainment business in 84 countries including India. It has published weekly and delivered internationally since 1933, the publications. According to the Plaintiffs their publications have been the unchallenged leaders in respect of publications connected with the industry providing even same day coverage thereof. In paragraph 5 of the plaint details are furnished to establish the Plaintiffs' reputation and goodwill.

5. On 21st January, 2006, the Plaintiff made an application under the Trade Marks Act, 1999 for registration of the mark "Variety" under Class 16 and Class 42. It is important to note that in these applications the Plaintiff stated its user to be since February 2002 in respect of the application under Class 16 and since February 2001 in respect of the application under Class 42.

6. The Plaintiffs claim to have come to know about the Defendants user of the said mark only in the year 2006. The Plaintiffs thereupon through their advocate's addressed to the Defendant a cease and desist notice dated, 12th April, 2006. The Plaintiffs through their advocate addressed another cease and desist notice dated, 22nd September, 2006. The notices do not state the date from which the Plaintiff started using the mark in India.

7. The Plaintiffs filed the suit on 28th June, 2007. The suit referred to the applications for registration under Classes 16 and 42 dated, 21st January, 2006. The plaint thus, proceeded on the basis that the use was with effect from February 2001 and February 2002 in respect of Classes 42 and 16, respectively. In other words, the plaint undoubtedly proceeded on the basis of the Plaintiffs having entered the Indian market in or about the year 2002.

8(a). The Plaintiffs took out Notice of Motion No. 2642 of 2007. The Defendants filed a reply dated, 18th August, 2006 disclosing user by it of the said trade mark since the year 1991.

(b). Thereafter, on 14th December, 2007, the Plaintiffs amended the applications for registration dated, 21st January, 2006 changing the date of user of the mark from February 2002 to May 1984 in respect of the application under Class 16.

(c). In an affidavit in rejoinder dated, 30th January, 2008, the Plaintiff referred to the above application for amendment dated, 14th December, 2007.

(d). No opposition was filed to the Plaintiffs' application for registration, either before the amendment dated, 14th December, 2007 or thereafter.

(e). On 14th July, 2008 and 15th July, 2008, the Plaintiffs' marks were registered with respect to Classes 42 and 16, respectively.

9. By an Order dated, 17th March, 2009, the Plaintiff was allowed to amend the plaint *inter alia* by introducing some of the above facts relating to the application for amendment of the date of user in respect of the applications for registration, the fact of registration of the Plaintiffs mark and making consequential amendments based thereon including the addition of a claim for infringement of the registered trade mark.

10. Thereafter, the Plaintiff took out Notice of Motion No. 1566 of 2009 seeking interim reliefs against the infringement of the Plaintiffs' marks which were registered after the suit was filed and pursuant to the above amendment of the plaint introducing the case for infringement of trade mark.

11. The first question that arises is whether the Defendant used the mark "Variety" and in the stylized form before the Plaintiffs user thereof in India.

12. There can be little if any doubt that the Defendant has been using the mark "variety" since the year 1991-92. The correspondence, receipts, bills, challans and publications annexed to the affidavit in reply in Notice of Motion No. 2642 of 2007 appear to be genuine. They all pertain to the period 1991-92 onwards and clearly indicate the use of the word "Variety" by the Defendant. What is even more important is the correspondence addressed by the government Authorities including public libraries which refer to the use of the word variety in the Defendant's publications such as "variety bankers and financial directory". There is also a letter from the Department of Industries and Commerce, placing an Order for the Defendant's "Variety International Leather Directory". The publications were also produced in Court. There is no reason whatsoever to doubt the genuineness thereof. There is nothing which even remotely suggests that these publications were prepared recently.

13. In the circumstances, the Defendant has established the use of the mark "variety" in relation to its various publications from the year 1991-92.

14. In paragraph 2 of the said affidavit-in-reply, the Defendant expressly stated that the Plaintiffs goods and services were available in India only since 2001-02 whereas, the Defendant has been using the mark since 1991 openly, extensively and continuously and are therefore, prior user thereof in India. Had the matter

rested there the Defendant had a complete answer to the Plaintiffs action on infringement u/s 34 of the said Act, which reads as under:

34. Saving for vested rights - Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior:

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his, whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.

15. Sub-clause (b) of Section 34 does not apply in this case, as admittedly use by the Defendant of the said mark was prior to the date on which the Plaintiff's marks were registered in India. The question therefore, is whether the Defendant continuously used the said mark in relation to the said goods from a date prior to the use of the said mark in relation to the said goods by the Plaintiff. The Plaintiff claims to have used the mark in India at least since the year 1984 whereas, the Defendant contends that the Plaintiffs first use of the mark in India was only in the year 2001, as stated in the unamended copy of the Plaintiffs application for registration of the said mark.

16. Before dealing with this factual aspect it is necessary to consider a question of law, namely whether the word "use" referred to in Section 34 and in particular Clause (a) thereof pertains to use anywhere in the world or only in India. If the term pertains to the use of a mark anywhere in the world the Plaintiffs must succeed for they have established the use of the mark overseas decades before 1991.

17. In my opinion; however, Section 34(a) pertains to the use of or mark in India and not anywhere in the world. The reliance by Mr. Chitnis on the Judgment of the learned Single Judge of the Calcutta High Court in *Aktiebolaget Jonkoping Vulcan Vs. V.S.V. Palanichamy Nadar and Others*, is well founded. That was an appeal u/s 109(2) of the Trade and Merchandise Marks Act, 1958 from the decision of the Deputy Registrar of Trade Marks allowing the Respondent's application for rectification and expunging the Appellant's trade mark. The Appellant was a Swedish Match Company. The Respondent filed an application u/s 46 of the 1958 Act on the ground that there had no bona fide use of the mark by the Appellant for the statutory period of a continuous stretch of five or more years upto one month before the date of the application for rectification. On this issue, the learned Judge came to the conclusion in favour of the Respondent. The learned Judge held that the mark had never have been used in India and that in

fact the Appellant did not even establish that it believed that it could in the near future use the mark. In paragraph 20 of the Judgment, the learned Judge held that use abroad and advertisements abroad are not of any assistance to the Appellant. After referring to several Judgments and Orders, the learned Judge held as under:

27. On principles I take the same view. The Trade Mark law from that point of view is not extraterritorial; that use abroad in foreign countries under foreign registration can be use within the meaning of the Indian Trade and Merchandise Marks Act of 1958. This statute is an Act which provides for registration and better protection of trade marks and for the prevention of the use of fraudulent marks on merchandise. That is its preamble. That preamble I read as confined to the territorial limits of India. Section 1(2) of the statute extends it to the whole of India. The statute establishes trade marks register for India. The definition of a trade mark in Section 2(v) speaking of use in relation to goods must in my opinion be understood as use within the territory of India and not use abroad. On the Authorities quoted above and on the principles that I have just mentioned I am of the opinion that u/s 46 of the Trade and Merchandise Marks Act, 1958 the word "use" employed therein is used within India. Naturally, if it is not used in India that would be a ground for removal from the Indian register. I cannot imagine that a foreign use or use abroad or outside India could be pleaded as a sufficient ground for retaining a registered Trade Mark on the Indian Trade Mark register. I cannot import any extra-territorial notion to construe the Indian Trade and Merchandise Marks Act, 1958 to cover foreign use. I am of the opinion that registration of a Trade Mark and its continuance on the register are exclusively within the scope and ambit of domestic and national law. The "International convention for the protection of Industrial property" originally of Paris in 1883 and recently revised at Lisbon in 1958 clearly recognises the principle specially in its Article 6 that when a Trade Mark has been duly registered in the country of origin and is then registered in other Convention Countries, each of these national marks is to be considered as independent, and the renewal of registration in the country of origin does not involve the obligation to renew in other Convention Countries. As I read the British law a Trade Mark registration, whether of a British citizen or a foreigner, and whether with Convention priority or not is consistently regarded as completely independent of any foreign registration. I am therefore of the opinion, both on the interpretation of the Indian Statute and on principle, that registration of the "Three Stars" Trade Mark of the Swedish Match Company in foreign or Convention Countries, cannot help the Appellant in this appeal, on the question of Indian registration and its Statutory Conditions under the Indian Trade Mark and Merchandise Marks Act, 1958.

I am in respectful agreement with the Judgment of the Hon'ble Calcutta High Court. The position remains the same even under the Trade Marks Act, 1999. Section 1(2) of the 1999 Act also extends to the whole of India. Section 47 of the 1999 Act corresponds to Section 46 of the 1958 Act. In my opinion the

observations with regard to the term "use" in Section 46 of the 1958 Act and Section 47 of the 1999 Act must in this respect also apply to that term in Section 34 of the 1999 Act. The nature of the term "use" in both the Sections viz. 34 and 47 of 1999 Act is the same. The ratio of the Judgment would therefore, apply with equal force to a case u/s 34 as it does to one u/s 47.

18. The Plaintiffs first use of the said trade mark in India must therefore be determined. If it was prior to 1991 the Plaintiffs' action for infringement must succeed. If not, the Defendant's challenge u/s 34 is established.

19. As noted earlier, the plaint, as originally filed, proceeded on the basis that the first user of the mark in India by the Plaintiffs was only in the year 2001. In its affidavit in reply to Notice of Motion No. 2642 of 2007, the Defendant stated that it had used the said mark since the year 1991-92. It was only thereafter, that the Plaintiff amended its application for registration by changing the date of the first user in respect of Class 16 from February 2002 to May 1984. The registration was thereafter, granted on 15th July, 2008 and the above Notice of Motion No. 1566 of 2009 claiming interim reliefs on the basis of infringement, was taken out. This in turn was pursuant to the amendment of the plaint, being allowed by the said Order dated, 17th March, 2009.

20. Mr. Chitnis submitted that the Plaintiffs entire case regarding the date of first use being in the year 1984 was an afterthought and with a view to meet the Defendant's case in the reply.

21. The affidavit in support of Notice of Motion No. 1566 of 2009 furnishes the details of the alleged user by the Plaintiff of the said mark since the year 1984. The Plaintiffs case is that their publications sold and circulated under the "Variety" marks had a tremendous goodwill and reputation in India which arises from the coverage/reporting in the said publications of events and developments pertaining to the Indian Film Industry and Indian Films/Panorama since the early 1950s. The publications covered important events in the film industry including film releases and government policies. The coverage was through the various correspondents of the Plaintiffs "Variety" magazines in India. The correspondents represented the magazine in India vis-à-vis the members of the film trade and the public by interacting with actors, directors, producers in India and conducting interviews of film personalities. The Plaintiffs overseas representatives had also been deputed from time-to-time to remain present and represent the Plaintiffs publications in international film festivals, conducted in India. The above, according to the Plaintiff, associated its publications with the Indian motion picture industry, created awareness of the Plaintiffs publications and generated tremendous reputation and goodwill in respect of the their publications.

22. In support of the above contentions, Dr. Tulzapurkar relied in the first instance upon several excerpts from a series of publications dating as far back as 6th June, 1956. Most of these publications; however, relate to articles/information about the Indian film industry in foreign publications. This would be

of no assistance to the Plaintiff as the same would not establish the use of the mark in India. Exh. 6 to the affidavit refers to an article about the film "Sholay". The article does mention at the beginning-"New Delhi February 8". Dr. Tulzapurkar contended that this indicated that the article was written by the Plaintiffs' Indian correspondent from Delhi. The article does refer to the statements by the producer of the film, one Mr. G.P. Sippi. There is however, nothing in the article which indicates that the information was gathered at an interview or by the said producer was aware of the Indian all the other/ correspondent and/or his association with the Plaintiff. The information could well have been derived from other sources available even outside India. The article by itself does not establish the Plaintiffs case. However, the fact that it originated from New Delhi may be considered in the Plaintiffs' favour in the totality of circumstances, but not by itself as establishing the Plaintiffs case.

23. Similarly, Exh. 8 to the affidavit refers to an article/report of the Indian film industry dated, 13th March, 1982. The article/report is stated therein to be by N.V. Eswar. It is further stated to be from Madras. This article/report provides an analysis of various features of the Indian film industry. It does not by itself establish the Plaintiffs case of the use of the mark in India. However, the fact that it originated from Madras is a factor which may be considered in the Plaintiffs' favour.

24. Dr. Tulzapurkar also relied upon an issue of the "Variety" magazine dated, 24th January, 1990 which carried a report on the 21st Indian Film Festival covered by overseas their journalist which was a report from Calcutta. The contents thereof do not indicate any disclosure by the correspondent either to the public in general or to any person in the film industry in India about the identity of the correspondent or her association with the Plaintiff.

25. Dr. Tulzapurkar then relied upon the evidence of a public library in India having subscribed to the Plaintiff's "Variety" publications. He submitted that the availability of the publications in a public library establishes the use by the Plaintiffs of the mark in India and that the same had acquired tremendous reputation, recognition and goodwill in India.

The evidence comprises of the availability of the said publications with the National Film Archive of India (NFAI). The NFAI was established in February 1964 as a media unit of the Ministry of Information and Broadcasting. The NFAI maintains a library of Indian and international books and periodicals on Indian and foreign cinema and related arts. It is contended that the library is widely used by individuals connected with the industry. The Plaintiffs contend that at least since the year 1984 NFAI has been subscribing to the "Variety" publication. A copy of the first page of the "Variety" magazine dated, 11th January, 1984 was relied upon. On the right hand corner is a stamp of the NFAI bearing the dated, 10th May, 1984 which refers to the date on which the NFAI received the copy. It is contended that this establishes that the magazine was subscribed to and was available in India at least from the year 1984. Further, copies of further

publications subscribed to by NFAI from the year 1988 to 1990 are also relied upon. Similar stamps/endorsements appear on the right hand corner of each copy indicating the date of receipt thereof by the NFAI.

26. The Plaintiff relied upon affidavit of one Ms. Mithuni Mehta who visited the NFAI and obtained the copies. In her affidavit dated, 30th January, 2008 annexed as Exh. 19 to the Plaintiff's affidavit, Ms. Mehta states that she visited NFAI and the American Library which evidenced the availability of the Plaintiffs "Variety" publications since at least the year 1984. She states that the library staff at NFAI informed her that the issues of the said publications were available and that the earliest copy located was of the year 1984. Pausing here for a moment, it is necessary to note that Ms. Mehta also referred to publications available with the Central Public Library, Mumbai. The said publications however pertain to the year 1992 and are therefore, not relevant. The publications referred to by her with the American library are of no assistance either, for there is nothing to show that the same were available with the American library prior to 1991. In other words, there is nothing to show that the American library did not develop its archive after 1991-92 comprising publications relating to a period prior thereto.

27. Reverting to the evidence regarding the availability of the Plaintiffs publications with the NFAI it is necessary to note that the affidavit clearly indicates that the NFAI which was constituted in February 1964 did not merely develop its archive with copies of the previous publications of the Plaintiff. If that was not so, there was no explanation for the endorsement of the years 1984 and 1988 to 1990 on the said publications. As rightly pointed out by Dr. Tulzapurkar when this evidence was produced, the Defendant made no attempt to indicate otherwise. In other words, the Defendant did not produce any evidence which suggested that the copies of the Plaintiffs publications were obtained by the NFAI after the year 1991-92. This fact viewed along with the endorsement on each of the copies indicates that the NFAI obtained the publications contemporaneously to the publication thereof.

28. The availability of publications with a library stand on an entirely different footing from an individual or a few individuals having copies thereof, for their private use. The availability of publications with a library prima facie at least indicates their availability to the public in general. The same would also indicate that the same were read by the members of the public. Normally at least at the interlocutory stage it would be reasonable to presume that the library subscribed to the publication on the basis that there is a demand and/or that there is a likelihood of development of a demand for the same. The continued subscription to such publications would indicate the development of a demand for the same even if there was none when the publication was initially subscribed to. This, I appreciate is a question of fact. I can visualize cases where the mere availability of a publication in a library would not necessarily indicate that it is read by people having access to the library. This however, has not been suggested on behalf of the Defendant in the case of said publications.

In the circumstances, the Plaintiffs have established the use of the mark in India at least since the year 1984.

29. In the result, it is clear that copies of the Plaintiffs publication have been available and used in India at least since the year 1984. Moreover, the fact that the publications were available at the NFAI indicates a strong prima facie case that it was read in India.

30. I base the finding regarding the Plaintiffs use of the mark "Variety" in India, essentially upon the fact that NFAI which maintained a library subscribed to the magazine. The articles in the said publications originating from India only support this factor.

31. I place no importance upon the mere fact that articles regarding the Indian film Industry appeared in the overseas publications of the Plaintiff. Unless there is evidence to the contrary, the same would only indicate the use thereof inter alia by people interested in Indian films abroad. The fact that such readers travel to India would not establish a trans-border reputation. Publications such as these, stand on an entirely different footing from other goods and services such as hotels or restaurants. People from this country who travel abroad, would be exposed to goods and services widely used, advertised and made available abroad. Prima facie at least there would be no necessity for people of this country traveling abroad to either look for or commonly come across publications on the Indian film industry. They would have no need for the same abroad as they would normally subscribe to Indian publications available in India for the same information. There is nothing to indicate that the material published by the Plaintiffs in this regard would not be available easily in publications in this country. Nor is there any material to establish that the Plaintiffs' other publications would be either openly available to or accessed by people of our country travelling abroad.

32. There is considerable force in Dr. Tulzapurkar's submission that the adoption of the mark is not honest. In the year 1993-94, the Defendant used a similar font in the letters of the word "Variety". In the year 1995-96, the Defendants used the identical stylized form of the letter "V" wherein, the second stroke of the letters continues over the letters "ariet" in the shape of the blade of a cutlass. The only difference in this extension to the second stroke of the letter "V" is that in the Plaintiff's mark extends upto the last letter "y" whereas, the Defendant's mark extends only upto the letter "t". That however, is of absolutely no consequence. The impression quite clearly is that the Defendant's mark in the stylized form is really the Plaintiffs mark.

33. Mr. Chitnis was unable to offer any explanation for the Defendant's adopting this stylized form. This is an important aspect while considering the question of honesty of adoption. Mr. Chitnis submitted that if the Defendant had any dishonest intention, it would have copied the same at the outset and not after a period of one year. The explanation for adopting the mark is difficult to accept, in

view of the virtual identical copy by it of the stylized form thereof. There is no explanation for what led to the Defendant's adopting the stylized form of the letter "V". The absence of an explanation in this regard also supports the Plaintiffs' case regarding the word mark per se.

34. In its affidavit-in-reply in Notice of Motion No. 2642 of 2007 the Defendant stated that it adopted the word "Variety" to denote the existence of directories in a variety of fields of activities and because of the variety of information available in each directory. Considering the adoption of the stylized form as above, I am not inclined to accept this explanation.

35. Further there is no explanation why the Defendant abandoned its application for registration of the mark. The Defendant had made an application on 5th November, 1992 for registration of the word mark "Variety" in respect of Class 16. The same however, was abandoned. Nor is there any explanation why the Defendant made a fresh application on 4th October, 2006 i.e. after the Plaintiffs application for the said mark in Class 16. As stated earlier the Plaintiffs had made an application for registration of its mark on 21st January, 2006.

36. What is important to note is that in paragraph 4 of the affidavit-in-rejoinder the Plaintiff had specifically drawn attention to the fact that there was no explanation for the same.

37. In paragraph 4 of the rejoinder, the Plaintiff stated that there was no explanation whatsoever forthcoming as to the adoption of the flying "V" logo written in the stylized manner namely the second stroke of the letter "V" extending over the other letters. Despite that, no explanation was forthcoming. The Defendant therefore, not merely had an opportunity to meet this argument but was expressly invited to do so. The Defendant having declined to offer any explanation, despite the same, compels me to accept Dr. Tulzapurkar's submission that the Defendant's adoption of the mark was not honest. An unexplained similarity is a relevant and important consideration while testing the question of honesty of adoption of the mark.

38. It is important to note that the Defendant's application for registration was not opposed. This was so even after the Plaintiff amended its application for changing the date of its first user. The Defendant was admittedly aware of the same. Mr. Chitnis submitted that this was probably because the Defendant did not consider it financially feasible to do so.

39. I do not for a moment suggest that the Defendant not having opposed the application for registration is not entitled to defend the present proceedings. The conduct however, is a factor which must be taken into consideration against the Defendant. Considering all the facts and circumstances of the case, this must be a factor to be weighed in the balance against Defendants.

40. The record does not disclose any acquiescence on the part of the Plaintiffs in the use of the mark by the Defendant. There is nothing to show that the Plaintiff

was aware of the use of the mark by the Defendant prior to 2006. Some of the factors relied upon by Mr. Chitnis have not been pleaded. For instance Mr. Chitnis submitted that the Plaintiffs having correspondents in India would have knowledge of the existence of the Defendant's directories and that the Plaintiff ought to have taken a search of the website and at the office of the Registrar of Trade Marks. Acquiescence is a question of fact. For instance, even if a search had been taken in the registry, it would have disclosed that the mark had been abandoned. Further, there is no pleading as to how the Plaintiffs conduct encouraged the Defendants to develop a reputation. The Defendant publishes its directories annually. There is no evidence on record showing that the circulation of the Defendant's publication is such that it would necessarily have come to the knowledge of others, including the Plaintiff/Plaintiffs correspondents. Had this been pleaded the Plaintiff would have had an opportunity of meeting the same. The mere fact that Defendant had used the same as part of its website cannot be held against the Plaintiff. The Plaintiff was not bound to take a search and involve itself in any extensive, investigative process. It is not necessary therefore, to refer to the various Judgments cited by Counsel on the question of delay and acquiescence.

41. Whether the Plaintiff was bound to obtain registration under the Registration of Books Act, 1867, is not relevant for the purpose of these proceedings. Even assuming that it was bound to obtain registration, at the highest, the Plaintiff would be visited with the consequences for non registration under the said Act. The same would not be a defence for an action for infringement or passing off.

It is not necessary to consider the Judgments on the question that the trans-border reputation must be as on the date of the Defendant's user. I have proceeded on the basis that it must be so. Nor do I see any substance in the contention that the class of users or readers would be different. The Defendant's directories are also in English.

42. In the circumstances, the Plaintiff has made out more than just a strong prima facie case of infringement of its trade mark "Variety" and of its copyright.

43. I however, do not find the Plaintiffs having established its case of passing off. The record does not indicate the Plaintiffs having developed a reputation in India sufficient to maintain an action for passing off. The availability of the Plaintiffs publication with NFAI does not establish a reputation sufficient for the same.

44(a). Notice of Motion No. 2642 of 2007 is made absolute in terms of prayer Clause (b). Notice of Motion 1566 of 2009 is made absolute in terms of prayer Clause (a).

(b) The Defendant shall disclose on or before 30th November, 2009 on affidavit details of its existing stock and shall be entitled to dispose of its existing stock on or before 31st March, 2010.

(c). The Order is stayed up to and including 31st December, 2009.